



DEPARTMENT OF COMMERCE

Patent and Trademark Office

Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; DOCX Submission Requirements

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice of information collection; request for comment.

SUMMARY: The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995, invites comments on the proposed information collection: DOCX Submission Requirements. The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

DATES: To ensure consideration, comments regarding this information collection must be received on or before **[INSERT DATE 60 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER]**.

ADDRESSES: Interested persons are invited to submit written comments by any of the following methods. Do not submit Confidential Business Information or otherwise sensitive or protected information.

- *Federal Rulemaking Portal:* <https://www.regulations.gov>.
- *Mail:* Justin Isaac, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-7728; or by email at raul.tamayo@uspto.gov with “DOCX ICR comment” in the subject line. Additional

information about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

On August 3, 2020, the USPTO published a final rule in the Federal Register that included a new fee set forth in 37 CFR 1.16(u). See Setting and Adjusting Patent Fees in Fiscal Year 2020, 85 FR 46932. Although that final rule indicated the new fee at §1.16(u) would go into effect on January 1, 2022, the effective date of the new fee was delayed to give applicants more time to adjust to filing patent applications in the DOCX format.

As specified in §1.16(u), the fee is due for any application filed under 35 U.S.C. 111 for an original patent—except design, plant, or provisional applications—where the specification, claims, and/or abstract do not conform to the USPTO requirements for submission in the DOCX format. Therefore, the fee is due for nonprovisional utility applications filed under 35 U.S.C. 111, including continuing applications, that are not filed in the DOCX format.

The USPTO conducted two pilot programs for filing applications in the DOCX format. The eMod Text Pilot Program was conducted between August 2016 and September 2017. The USPTO then expanded the ability to file patent applications in the DOCX format in EFS-Web to all users in September 2017. In 2018, the USPTO launched the Patent Center and conducted the Patent Center Text Pilot Program from June 2018 through April 2020. All applicants have been able to file applications in the DOCX format in the Patent Center since April 2020. Information about the Patent Center is available at www.uspto.gov/PatentCenter. The USPTO continues to hold many discussions and training sessions with stakeholders to ensure a fair and reasonable transition to the DOCX format. In addition, to further ensure a fair and reasonable transition to the DOCX format, the USPTO has, since April 2022, provided patent applicants with the option to submit a

back-up applicant-generated PDF version of the application along with the DOCX file(s) when filing an application in Patent Center. See Extension of Period To Allow Submission of a PDF With a Patent Application Filed in DOCX Format, 87 FR 77812 (Dec. 20, 2022).

The items in this proposed new information collection relate solely to the impacts of the § 1.16(u) non-DOCX filing surcharge fee on the filing of nonprovisional utility applications under 35 U.S.C. 111, including continuing applications. In particular, this proposed new information collection accounts for the § 1.16(u) non-DOCX filing surcharge fee itself, as well as an additional 30 minutes of time to accommodate the (i) extra review that some respondents may undertake as they start to become more familiar with the DOCX format and (ii) submission of the back-up applicant-generated PDF that some respondents will opt to submit.

The estimated volumes for the items in this proposed new information collection are based from the estimates for the corresponding nonprovisional utility applications filed under 35 U.S.C. 111, including continuing applications, that are covered under an existing OMB clearance (0651-0032; Initial Patent Applications). Respondents for the items in the proposed new information collection will either take an extra 0.5 hours to file their applications in DOCX format or they will pay the non-DOCX surcharge, they will not do both.

II. Method of Collection

Patent Applications can be submitted electronically via the USPTO's patent electronic filing system, by mail, or by hand delivery to the USPTO. Patent applications submitted in the DOCX format will be submitted electronically.

III. Data

OMB Control Number: 0651-New.

Forms: None.

Type of Review: New.

Affected Public: Private sector, individuals and households.

Respondent's Obligation: Required to obtain or retain benefits.

Estimated Number of Annual Respondents: 411,817 (including 164,066 respondents from filing fees).

Estimated Number of Annual Responses: 411,817 (including 164,066 responses from filing fees).

Estimated Time per Response: The USPTO estimates that the responses in this information collection will take the public approximately 30 minutes (0.5 hours) to complete. This includes the time to create the document and submit the completed item to the USPTO. The USPTO provides the 30-minute estimate out of an abundance of caution for the initial period after the effective date of the non-DOCX filing surcharge fee. The USPTO expects to decrease the 30-minute estimate by the first renewal of this collection as the public more fully comprehends the nature of, and how to comply with, the DOCX format.

Estimated Number of Annual Respondent Burden Hours: 123,877 hours.

Estimated Number of Annual Respondent Hourly Cost Burden: \$53,886,495.

Table 1: Total Burden Hours and Hourly Costs to Private Sector Respondents

Item No.	Item	Estimated Annual Respondents	Responses per Respondent	Estimated Annual Responses	Estimated Time for Response (hours)	Estimated Burden (hour/year)	Rate ¹ (\$/hour)	Estimated Annual Respondent Cost Burden
		(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) = (e)	(f)	(e) x (f) = (g)
1	DOCX submission of Original New Utility Applications	170,510	1	170,510	0.5	85,255	\$435	\$37,085,925
2	DOCX submission of Utility Continuation/Divisional of an International Application	6,049	1	6,049	0.5	3,025	\$435	\$1,315,875
3	DOCX submission of Utility Continuation/Divisional Applications	57,044	1	57,044	0.5	28,522	\$435	\$12,407,070
4	DOCX submission of Utility Continuation-in-Part Applications	6,516	1	6,516	0.5	3,258	\$435	\$1,417,230
	Totals	240,119	---	240,119	---	120,060	---	\$52,226,100

¹ 2021 Report of the Economic Survey published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); the USPTO uses the mean IP billing rate for attorneys in private firms which is \$435 per hour. (<https://www.aipla.org/home/news-publications/economic-survey>; pg F-27).

Table 2: Total Hourly Burden for Individual and Household Respondents

Item No.	Item	Estimated Annual Respondents	Responses per Respondent	Estimated Annual Responses	Estimated Time for Response (hours)	Estimated Burden (hour/year)	Rate ² (\$/hour)	Estimated Annual Respondent Cost Burden
		(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) = (e)	(f)	(e) x (f) = (g)
1	DOCX submission of Original New Utility Applications	5,420	1	5,420	0.5	2,710	\$435	\$1,178,850
2	DOCX submission of Utility Continuation/Divisional of an International Application	192	1	192	0.5	96	\$435	\$41,760
3	DOCX submission of Utility Continuation/Divisional Applications	1,813	1	1,813	0.5	907	\$435	\$394,545
4	DOCX submission of Utility Continuation-in-Part Applications	207	1	207	0.5	104	\$435	\$45,240
	Totals	7,632	---	7,632	---	3,817	---	\$1,660,395

Estimated Total Annual Respondent Non-hourly Cost Burden: \$49,588,160.

There are no maintenance costs, capital start-up costs, recordkeeping costs, or postage associated with this information collection. However, the USPTO estimates that the total annual (non-hour) cost burden for this information collection, in the form of filing fees) is \$49,588,160. The USPTO expects the DOCX format adoption rate to steadily increase as the public more fully comprehends the nature of, and how to comply with, the format. Thus, the USPTO expects the number of respondents that will pay the non-DOCX filing surcharge fee to decrease by the first renewal of this collection. Additionally, the USPTO expects the frequency and amount of any extra review time to decrease as respondents become more comfortable with the DOCX filing process.

Filing Fees

The items with filing fees are listed in the table below.

Table 3 : Filing Fee Costs to Respondents

Item No.	Fee Code	Item	Estimated Annual Responses (a)	Amount (b)	Totals (a) x (b) = (c)
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² Ibid.

1-4	1054	Non-DOCX Filing Surcharge Fee (undiscounted entity)	102,095	\$400	\$40,838,000
1-4	2054	Non-DOCX Filing Surcharge Fee (small entity)	47,406	\$160	\$7,584,960
1-4	3054	Non-DOCX Filing Surcharge Fee (micro entity)	14,565	\$80	\$1,165,200
		Totals	164,066	- - -	\$49,588,160

Postage

There are no postage costs associated with items in this information collection. The actual submission of patent applications, and any postage cost burden, is covered by OMB control number 0651-0032 (Initial Patent Applications).

IV. Request for Comments

The USPTO is soliciting public comments to:

- (a) Evaluate whether the proposed collection of information is necessary for the proper performance of the functions of the Agency, including whether the information will have practical utility;
- (b) Evaluate the accuracy of the Agency's estimate of the burden of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) Enhance the quality, utility, and clarity of the information to be collected; and
- (d) Minimize the burden of the collection of information on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

All comments submitted in response to this notice are a matter of public record. USPTO will include or summarize each comment in the request to OMB to approve this information collection. Before including an address, phone number, email address, or other personally identifiable information (PII) in a comment, be aware that the entire comment—including PII—may be made publicly available at any time. While you may

ask in your comment to withhold PII from public view, USPTO cannot guarantee that it will be able to do so.

Justin Isaac,

Information Collections Officer,

Office of the Chief Administrative Officer,

United States Patent and Trademark Office.

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